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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,446	12/16/2003	Thomas D. Kelly	DI-5928 (112713-457)	8102
29200	7590	12/12/2007	EXAMINER	
BAXTER HEALTHCARE CORPORATION			DEAK, LESLIE R	
1 BAXTER PARKWAY			ART UNIT	PAPER NUMBER
DF2-2E			3761	
DEERFIELD, IL 60015			MAIL DATE	DELIVERY MODE
			12/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>  10/738,446	<b>Applicant(s)</b>  KELLY ET AL.
	<b>Examiner</b>  Leslie R. Deak	<b>Art Unit</b>  3761

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 03 October 2007.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-107 is/are pending in the application.  
4a) Of the above claim(s) 1-13 and 39-107 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 14-38 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 06 July 2006 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments to the claims have been entered and fully considered. Claims 1-13 and 39-107 are withdrawn from consideration. Claims 14-38 are examined on the merits herein.

### ***Election/Restrictions***

2. While the addition of the balance chamber may not render the two groups of inventions materially different in design, the invention in claims 99-107 have a materially different mode of operation from the invention in claims 14-38. The control scheme in claims 14-38 isolates a filtration chamber from the medical fluid circuit and delivers a bolus of fluid to the patient, while the control scheme in claims 99-107 isolates the filtering device from the balance chamber only, and then recirculates a volume of fluid to the balance chamber, without delivering any fluid to the patient. The inventions have different modes of operation since the control schemes do not encompass all of each other's steps.
3. In the interview on 6 September 2007, Examiner agreed to consider restricted claims 99-107 if the claims were amended to add the language from claim 14 to claim 99. However, it is the position of the Examiner that claims 99-107 remain patentably distinct from claims 14-38. Accordingly, claims 99-107 are withdrawn from examination.
4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 99-107 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 14-20, 33-35, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0104800 to Collins et al.

In the specification and figures, Collins discloses the apparatus as claimed by applicant. With regard to claims 14, 33-35 Collins discloses a hemodiafiltration apparatus comprising a medical fluid circuit 40, medical fluid supply 50, first pump 62 to supply medical fluid to filtration apparatus 10, second pump 44 operable to pull fluid from the filtering device, and isolating apparatus in the form of upstream and downstream valves 51, 55 (see FIG 1a, paragraphs 0037-0039). The device further comprises a control unit 110 that uses control schemes to operate the valves and pumps (see paragraph 0042). The controller may operate to close valves 51, 55 in order to place the cartridge in isolation or bypass mode and command pump 62 to deliver a volume of substitute fluid to the patient (see paragraph 0045).

With regard to claim 15, Collins discloses that the volume of fluid issued to the patient is a bolus volume issued to maintain proper patient fluid balance, meeting the limitations of the claims (see paragraph 0045).

With regard to claim 16, Collins discloses that the control scheme is programmed to receive user input before delivery of the bolus (see paragraph 0045).

With regard to claims 17-18 regarding the bolus volume entered by the operator (17) and that the bolus volume is predetermined prior to therapy (18), Applicant's recitation with regard to the operation of the controller is not a positive structural limitation and only sets forth what the controller is capable of doing when prompted by an operator. Apparatus claims cover what a device is, not what it does. See MPEP 2114. In the instant case, Collins discloses that the apparatus may provide a specified bolus volume (see paragraph 0045). There is no language in the claims regarding the actual function of the device; the claims set forth a method of operating and programming the device. Accordingly, it is the position of the examiner that the Collins device is capable of being used by an operator to control the pumps and valves as claimed by applicant, thereby meeting the limitations of the claim.

With regard to claims 19 and 20, Collins discloses that the control scheme relies on input from various pressure and flow sensor devices (such as a blood flow sensor which corresponds to applicant's blood volume sensor) in delivery of the bolus volume (see paragraphs 0011, 0045).

With regard to claim 38, Collins discloses that the apparatus may comprise a temperature sensor, wherein the control scheme is programmed to halt the first pump 62 if the rate of temperature decay exceeds a certain value (see paragraph 0011).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0104800 to Collins et al in view of US 5,932,103 to Kenley et al.

In the specification and figures, Collins discloses the device substantially as claimed by applicant (see rejection above).

With regard to claims 21, 23, and 26, Collins fails to disclose that the bolus delivered to the patient comprises a rinseback volume delivered at the end of therapy. Kenley discloses a dialysis system configured to allow postdilution (see column 51, lines 14-20) that also uses dialysis fluid as a rinseback fluid that is communicated to the patient after the completion of therapy upon patient input as controlled by the valves, pumps, and optical sensors (see column 48, lines 1-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to program the system disclosed by Sternby to deliver a rinseback fluid to the patient after therapy, as

disclosed by Kenley, in order to ensure all extracorporeal blood is returned to the patient.

With regard to claim 22, Kenley discloses that the rinseback procedure is performed automatically, without manual operator input. It has been held that the elimination of an element and its function is obvious if the element is not desired. See MPEP 2144.04(II)(A). It is the position of the Examiner that the removal of automatic control from the apparatus suggested by Collins and Kenley is merely the removal of an undesired element (automation) and its function (automatic control). Accordingly, applicant's claim drawn to a manual operator input is an unpatentable variation of the prior art.

With regard to claims 24 and 25, Applicant recites the operation of the controller. Such limitations are considered by the examiner to lack positive structural limitations, and only set forth what the controller is capable of doing when prompted by an operator. Apparatus claims cover what a device is, not what it does. See MPEP 2114. There is no language in the claims regarding the actual function of the device; the claims set forth a method of operating and programming the device. In the instant case, it is the position of the examiner that the devices disclosed by the prior art are substantially structurally similar to the claimed device and are capable of being programmed to either function with operator input or automatically as claimed by applicant, thereby meeting the limitations of the claim.

With regard to claims 27, 29, and 32, Collins fails to disclose that the bolus delivered to the patient comprises a prime volume delivered at the beginning of therapy.

Kenley discloses a dialysis system configured to allow postdilution (see column 51, lines 14-20) that also uses dialysis fluid as a priming fluid that is communicated through the circuit before therapy as controlled by the valves, pumps, and air detectors of the circuit (see column 47, line 50 to column 46, line 27).

With regard to claim 28, Kenley discloses that the rinseback procedure is performed automatically, without manual operator input. It has been held that the elimination of an element and its function is obvious if the element is not desired. See MPEP 2144.04(II)(A). It is the position of the Examiner that the removal of automatic control from the apparatus suggested by Collins and Kenley is merely the removal of an undesired element (automation) and its function (automatic control). Accordingly, applicant's claim drawn to a manual operator input is an unpatentable variation of the prior art.

With regard to claims 30 and 31, Applicant recites the operation of the controller. Such limitations are considered by the examiner to lack positive structural limitations, and only set forth what the controller is capable of doing when prompted by an operator. Apparatus claims cover what a device is, not what it does. See MPEP 2114. There is no language in the claims regarding the actual function of the device; the claims set forth a method of operating and programming the device. In the instant case, it is the position of the examiner that the devices disclosed by the prior art are capable of being programmed to either function with operator input or automatically as claimed by applicant, thereby meeting the limitations of the claim.

9. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0104800 to Collins et al in view of WO 99/29355 to Sternby.

In the specification and figures, Collins discloses the device substantially as claimed by applicant (see rejection above).

With regard to claim 36, Collins fails to disclose that the device may be configured to alternately deliver fluid to the extracorporeal circuit either upstream or downstream of the blood filtering device in a single embodiment. However, Sternby illustrates that the device may be configured for upstream delivery in the embodiment shown in FIG 3, and downstream delivery in the embodiment shown in FIG 4. Taken together, the disclosures reasonably suggest to one of ordinary skill in the art both upstream and downstream bolus lines, providing both predilution and postdilution capability in a single configuration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add an upstream medical fluid delivery line to the apparatus disclosed by Collins in order to allow for predilution and postdilution in a single configuration.

With regard to claim 37, Collins fails to disclose that the medical fluid flow path comprises a line to remove ultrafiltrate upstream from the bolus delivery point. Sternby illustrates that the medical fluid flow path may comprise a drain line 12 to remove ultrafiltrate upstream of the location 21 in which medical fluid is delivered to the extracorporeal blood circuit in order to prevent fluid overload in the line (see FIG 4). Accordingly, it would have been obvious to one having ordinary skill in the art at the

time of invention to add to the Collins device a drain line upstream of the bolus delivery point as disclosed by Sternby in order to prevent fluid overload in the line.

### ***Response to Arguments***

10. Applicant's amendment and arguments filed 3 October 2007 have been entered and fully considered. Applicant's interpretation of the claim rejections in the non-final rejection of 3 May 2007 is correct. While the Examiner inadvertently omitted the number of the claim rejections in the statement of rejection on page 6 of the Office action, the detailed rejections on pages 7 and 8 clearly indicate the rejected claims.

11. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

12. While neither Sternby nor Kenley teach a system with a controller programmed to isolate the filtering apparatus from the medical fluid circuit while simultaneously issuing a fluid bolus to the patient, Collins does disclose such an apparatus. While FIG 9 of the Collins apparatus may not correspond to the claims as amended by applicant, FIG 1a and paragraph 0045 appear to disclose the claimed apparatus, rendering the instantly claimed apparatus unpatentable over the prior art of record.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

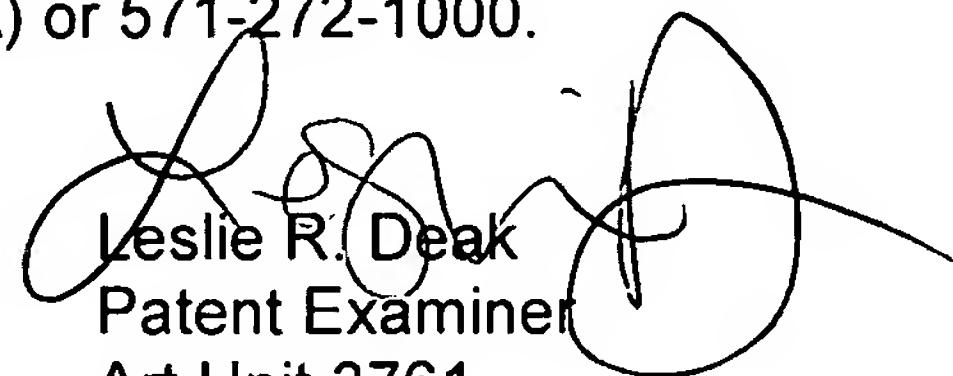
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 571-272-4943. The examiner can normally be reached on Monday - Friday, 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3761

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Leslie R. Deak  
Patent Examiner  
Art Unit 3761  
27 November 2007